

## **STATUS OF CLAIMS**

Claims 1 and 3-19 and 21 are pending.

Claims 1 and 3-19 and 21 stand rejected.

Claims 1, 18 and 21 have been amended herein.

Claims 2, 7-17 and 19 have been cancelled herein.

## **REMARKS**

### ***Change of Correspondence Address***

Applicant has previously submitted a form PTO/SB/122, requesting that all further correspondence be directed to the address associated with PTO Customer Account 45722. Applicant respectfully requests the Examiner please acknowledge receipt of this request.

### ***Amended Title***

A new title has been submitted herein indicative of the invention to which the present claims are directed.

### ***35 U.S.C. 103(a) Rejections***

Claims 1, 3-19 and 21 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Luchs (United States Patent No. 4,831,526) in view of Bosco (United States Patent No. 5,191,522), further in view of Aieta (United States Patent No. 6,839,689). Applicant requests reconsideration and removal of these rejections for at least the following reasons.

35 U.S.C. §103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

To establish a *prima facie* case of obviousness, all of the recited claim limitations must be taught or suggested in the prior art. *See, MPEP 2143.03; see also, In re. Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).* Further, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. *See, M.P.E.P. §706.02(j); see also, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*

Applicant notes: (1) the Office action fails to provide any motivation for combining Luchs and Bosco as argued, (2) the cited art fails in any combination to teach or suggest each of the recited limitations of the present claims, and finally (3) a proper motivation for combining the references to reach the presently claimed invention is necessarily lacking.

***1. The Office action fails to provide any motivation for combining Luchs and Bosco as argued***

The pending claims stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Luchs, Bosco and Aieta. The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).* The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).* Applicant may then traverse the Examiner's *prima facie* determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness. *In re Heldt, 58 C.C.P.A. 701, 433 F.2d 808, 811, 167 USPQ 676, 678 (CCPA 1970).*

The final rejections intermingle and refer to various portions of Luchs and Bosco as teaching different elements of the claimed invention. *See, e.g., 12/15/2006 Office action, par. 3 incorporating 3/31/2005 Office action Rejections, par. 4(A), ll. 1-15.* However, these rejections do not present any motivation what-so-ever for combining the teachings of Luchs and Bosco. More particularly, Applicant notes the March 31, 2005 Office action relies upon the combined teachings of Luchs and Bosco, but fails to present any motivation at all for combining these references as argued. Further, Applicant notes the March 31, 2005 Office

action explicitly states Applicant's prior arguments were considered, but are moot in view of the new grounds of rejection presented therein. Accordingly, Applicant submits a proper *prima facie* case of obviousness of any of the pending claims under the now asserted grounds of rejection is lacking, at least by virtue that no motivation for combining Luchs and Bosco in the manner asserted has been provided.

**2. *The cited art fails in any combination to teach or suggest each of the recited limitations of the present claims.***

Applicant submits the cited art fails, in any combination, to teach or suggest each of the limitations of any of the pending claims for at least the following reasons.

Claim 1, as amended recites:

A computer method for issuing at least one of a fidelity bond and a surety bond comprising:

storing underwriting data so as to be accessible by at least one computer processor;

storing data indicative of at least one of fidelity and surety bond customers so as to be accessible by said at least one computer processor;

inputting data indicative of at least one fidelity or surety bond to be issued and being associated with one of said bond customers;

automatically calculating a premium for the at least one fidelity or surety bond to be issued based on the input data and the underwriting data in response to a request therefore;

storing data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor;

selecting a sub-set of the data indicative of images of a plurality of pre-defined bond forms dependently upon the inputted data; and

automatically rendering the at least one fidelity or surety bond to be issued using said data indicative of bond customers, said selected data indicative of images of a plurality of pre-defined forms, and calculated premium in response to a request therefore;

wherein data indicative of said insurance underwriting instrument is automatically stored so as to be accessible to said at least one computer processor. (Emphasis added)

Support for the amendments to Claim 1 may be found throughout the specification. For example, support for “storing data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor” may be seen in Fig. 1, where database management layer 400 includes forms library 410. And, support for, “selecting a sub-set of the data indicative of images of a plurality of pre-defined bond forms dependently upon the inputted data” and “automatically rendering the at least one fidelity or surety bond to be issued using said ... selected data indicative of images of a plurality of pre-defined forms” can be found in the specification as originally filed, at page 15, line 11 – page 16, line 5, wherein it teaches:

The forms select server 320 provides the ability to search the bond forms library 410 for an appropriate set of bond forms based on identified selection criteria. The policy maintenance application 250 collects data from user input, and sends the collected data to the forms select server 320. The bonds form library 410 is queried and searched for appropriate bond forms based upon the input criteria. The forms select server 320 implements the mechanism to select either one or more bond forms from a list of bond forms that match the selection criteria.

The forms rendering server 330 provides functions to automatically “fill out” a bond form identified from the bond library 410 by the server 320. The policy maintenance application 250 passes the bond form name and information to the forms rendering server 330, which in turn generates the information required to fill out the input fields on the retrieved bond form. When complete, the retrieved bond form and the data for the bond form are returned to the policy maintenance application 250, which sends this information to the user interface layer 100 so that the retrieved bond form including relevant data can be displayed or printed using a device 110.

Such a presentation and rendered forms are also shown in Figs. 14-17 of the subject application. Accordingly, no new matter has been added thereby.

The cited art fails to teach or suggest such a combination of features. The Office action acquiesces that Luchs fails to teach the recited form rendering, as it instead imports select teachings of Bosco to teach such a feature. However, Bosco also fails to teach or suggest such a limitation. Instead, the examiner cited portion of Bosco merely teaches a medical underwriting program module 96 that generates correspondence required by the medical

underwriting process at page 26, line 62 – page 27, line 10. Thus, the relied upon portion of Bosco merely generates correspondence, and neither teaches nor suggests automatically rendering any insurance instrument using said data indicative of bond customers, said selected data indicative of images of a plurality of pre-defined forms, and calculated premium in response to a request therefore – no less the recited bonds of Claim 1.

**3. *A proper motivation for combining the references to reach the presently claimed invention is necessarily lacking***

A proper motivation for combining the cited art to reach the recited method that stores data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor; selects a sub-set of the data indicative of images of a plurality of pre-defined bond forms dependently upon the inputted data; and automatically renders the at least one fidelity or surety bond to be issued using the selected data indicative of images of a plurality of pre-defined forms, as is recited by Claim 1, is also lacking.

Applicant respectfully points out that each prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). That is, a *prima facie* case of obviousness can be rebutted where the cited art teaches away from the claimed invention in any material respect. *See, In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001). A reference teaches away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the applicant. *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517.

In the present case, Luchs, the primary reference, teaches away from the recited invention of Claim 1, as it clearly teaches a solution that diverges from that claimed by the Applicant. Again, Claim 1 recites, in part,

storing data indicative of images of a plurality of pre-defined bond forms so as to be accessible by said at least one computer processor;

selecting a sub-set of the data indicative of images of a plurality of pre-defined bond forms dependently upon the inputted data; and

automatically rendering the at least one fidelity or surety bond to be issued using said data indicative of bond customers, said selected data indicative of images of a plurality of pre-defined forms, and calculated premium in response to a request therefore. (Emphasis added)

Instead, Luchs teaches that when an insurance contract is to be issued, predetermined paragraphs are compiled and edited to create a custom tailored contract. *See, col. 3, l. 66 – col. 4, l. 11*. Luchs explains that the separate and complete paragraphs are then sequenced for printing in a desired order to yield an insurance contract. *See, col. 3, ll. 15-18*. Finally, Luchs explains that “[the approach of the Luchs’ system] is contrary to current practice wherein the client and the risk must be incorporated into existing contracts.” *See, col. 3, ll. 3-6*.

Accordingly, Luchs’ teachings conflict and teach away from the presently recited invention of Claim 1, which calls for storing, selecting and using images of pre-defined bond forms -- at least by virtue that Luchs seeks to avoid the use of predefined bond forms altogether in favor of generating streamlined, custom tailored contracts one-by-one, client-by-client. Accordingly, a prima facie case of obviousness is lacking for at least this reason as well. *See, e.g., In re Haruna, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001) holding a prima facie case of obviousness can be rebutted where the cited art teaches away from the claimed invention in any material respect.*

Further, the combined teachings of Luchs and Bosco cannot properly discount Luchs’ objective teaching to eliminate using predefined forms to reach the method of Claim 1 -- which calls for storing, selecting and using images of pre-defined bond forms. Again, the relied upon portion of Bosco merely teaches a medical underwriting program module 96 that generates correspondence required by the medical underwriting process at page 26, line 62 – page 27, line 10. Accordingly, incorporating the Examiner referenced teachings of Bosco into the system of Luchs would, at most, suggest generating custom correspondence in much the same manner as Luchs generates custom contracts – and not, automatically rendering the at least one fidelity or surety bond to be issued using said data indicative of bond customers, said selected data indicative of images of a plurality of pre-defined forms, and calculated premium in response to a request therefore.

Accordingly, Applicant respectfully requests reconsideration and removal of the rejection of Claim 1 as being unpatentable over Luchs, in view of Bosco and further in view of Aieta, at least by virtue that: (1) the Office action fails to provide any motivation for combining Luchs and Bosco as argued, (2) the cited art fails in any combination to teach or suggest each of the recited limitations of the present claims, and finally (3) a proper motivation for combining the references to reach the presently claimed invention is necessarily lacking. Applicant also requests reconsideration and removal of the rejections of Claims 3-6 as well, at least by virtue of these Claims ultimate dependency upon a patentably distinct base Claim 1.

Referring now to Claim 18, it has been amended to include the limitations of now cancelled Claim 19 and also analogously recite:

A data processing system for issuing a fidelity or surety bond, the system comprising:

at least one computer processor;

a first query-able plurality of memory locations storing data indicative of images of a plurality of forms, each of said forms being associated with a particular type of fidelity or surety bond;

a second query-able plurality of memory locations storing data indicative of policies;

at least one user interface for inputting data indicative of an insurance client and data indicative of the fidelity or surety bond;

at least one calculator application responsive to said user interface and automatically calculating a premium for the insurance underwriting instrument based on the input data using said at least one computer processor and data indicative of one of the fidelity or surety bond; and

software for rendering selected ones of said plurality of forms using said data stored in said first and second pluralities of memory locations and calculated premium in response to a request from said user interface. (Emphasis added)

Accordingly, Applicant requests reconsideration and removal of the rejection thereof for at least those reasons discussed hereinabove.

Referring now to Claim 21, it has been amended to also analogously recite:

A computer method for issuing a fidelity or surety bond comprising:

identifying data stored in a plurality of memory locations and being indicative of a select one of a plurality of customers;

receiving data indicative of a fidelity or surety bond to be associated with said select customer;

automatically calculating at least one rate associated with said fidelity or surety bond to be associated with said select customer using said data indicative of said customer and data indicative of said fidelity or surety bond to be associated with said select customer;

selecting at least one of a plurality of forms for said insurance instrument using said data indicative of said fidelity or surety bond to be associated with said select customer; and

automatically rendering said at least one form using said at least one rate, said data indicative of said customer, and data indicative of said fidelity or surety bond to be associated with said select customer;

wherein, said calculating and rendering are performed using said at least one computing processor. (Emphasis added)

Accordingly, Applicant requests reconsideration and removal of the rejection thereof for at least those reasons discussed hereinabove.

Claims 2, 7-17 and 19 have been cancelled, without prejudice herein, subject to Applicant's right to reintroduce these, or analogous claims, in this or a related application.



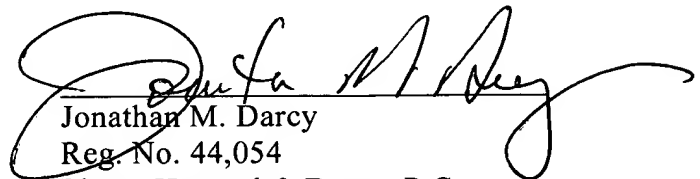
## CONCLUSION

Applicant believes he has addressed all outstanding grounds raised in the outstanding Office action, and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,

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